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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,766	01/02/2002	Jeffery Tabor	659/919	6310

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,766

Applicant(s)

TABOR ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6-8 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,6-8 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Unfortunately a Notice of Allowance cannot be issued at this time. The case has dragged out longer than it should, due to no fault of the applicant, but upon closer review of the references used previously and based on additional searching, the examiner is forced to make a new rejection at this time.
3. The indicated allowability of claims 2, 3, 6-8, and 17-20 is withdrawn. Rejections based on previously cited references follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

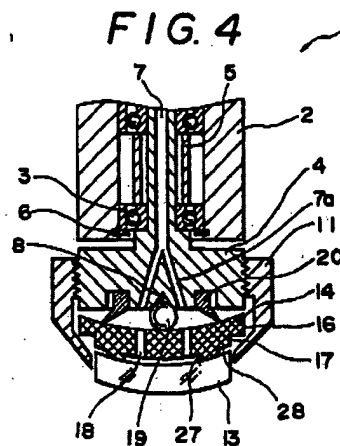
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (US Patent No. 5,291,692).

Takahashi discloses a carrier body (4) having a discrete part engaging outer surface with a generally convex top portion (27) and a generally convex recessed portion spaced inwardly from the top portion. As seen in Figure 4, the top portion (27) engages a lens (13) and the recessed portion includes communicating holes (18). The lens (13) is held thereto through suction provided by a communicating hole (7) of the holder body (4) and the

Art Unit: 1734

communicating hole (18) of the lens receptacle (14) under the drive of the suction pump (not shown). The holder body (4) is rotatably supported and formed on a rotating shaft which is rotatable about an axis substantially normal to the bottom surface of the recessed portion. The embodiment of interest is pictured below.

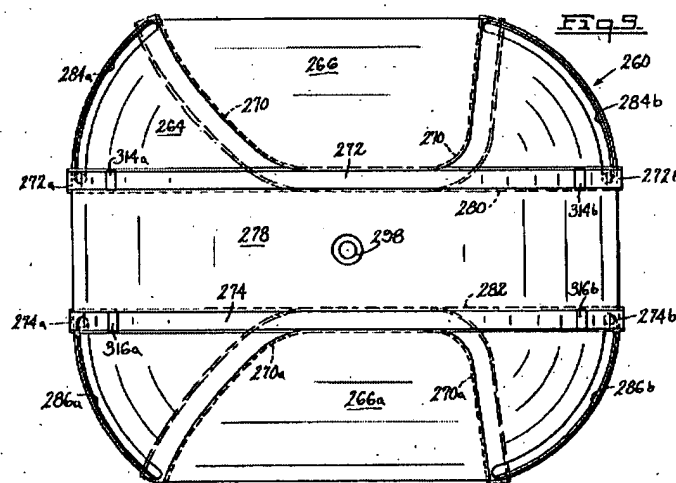


It appreciated that this prior art is not in the same field of endeavor of the apparatus presented in the applicant's specification. However, "apparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). (See MPEP §2114.) "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). (See MPEP §2115.)

Regarding the preamble of the claim, "[I]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim

6. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Oshefsky et al. (US Patent No. 4,578,133).

Oshefsky discloses an apparatus for applying discrete strips to a web of material. The embodiment of interest is the one shown in Figures 9, 10, and 11. Figure 9 shows a plain view of the transfer member (260) which as can be seen in Figures 10 and 11 has a generally beveled or convex upper surface (264). Of particular interest is the land portion (278) which includes is considered equivalent to applicant's recessed portion and the flexible strip supports (272, 274) which are considered equivalent to applicants top portion. Oshefsky also teaches that the strips can be held to the transfer members with vacuum. The transfer member rotates at an axis normal to the bottom surface as shown in Figure 8. The Figures of interest to the examiner are presented below. (Col. 14, lines 42 through Col. 15, line 58; Col. 7, lines 48-53.)



Oshefsky discloses an apparatus for applying discrete strips to a web of material. The embodiment of interest is the one shown in Figures 9, 10, and 11. Figure 9 shows a plain view of the transfer member (260) which as can be seen in Figures 10 and 11 has a generally beveled or convex upper surface (264). Of particular interest is the land portion (278) which includes is considered equivalent to applicant's recessed portion and the flexible strip supports (272, 274) which are considered equivalent to applicants top portion. Oshefsky also teaches that the strips can be held to the transfer members with vacuum.

Art Unit: 1734

The transfer member rotates at an axis normal to the bottom surface as shown in Figure 8.

The Figures of interest to the examiner are presented above. (Col. 14, lines 42 through Col. 15, line 58; Col. 7, lines 48-53.)

Oshefsky is drawn to transporting leg elastics, however, McCabe teaches that such a mechanism (42) could also be used to transport absorbent pads. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the transfer mechanism in Oshefsky could also be used to transfer absorbent pads as shown in McCabe.

Oshefsky in view of McCabe does not disclose that the recessed portion is generally an hourglass shape. Allen discloses a label applicator which picks up a label (24) from a web (32) and teaches applying the label to an article (26). The applicator in Figure 6 shows the receiving face (62) having a recess (68) with a bottom surface. (Col. 9, lines 10-26.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a recess on the transfer element in Oshefsky in view of McCabe motivated by the fact that Allen teaches a recess is particularly helpful for labels with a relative thickness. Therefore, when there is a concern for the thickness of the element being transferred then a recess is within the purview of the artisan as taught by Allen. Furthermore, Allen suggests that the recess would be generally larger than the label applied and in the shape of the label. So when a recessed is used for transferring an absorbent pad, such as the one in McCabe, it is within the purview of the artisan to have the recess be in the shape of the absorbent pad, an hourglass shape.

Regarding claim 2, the recessed portion is located centrally as shown in Figure 9 of Oshefsky.

Regarding claim 6, Oshefsky discloses a carrier base adapted to support the transfer members as shown in Figure 8.

Art Unit: 1734

9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshefsky in view of McCabe and Allen as applied to claim 3 above, and further in view of Boothe et al. (US Patent No. 5,716,478).

Regarding claim 7, Oshefsky in view of McCabe and Allen does not disclose a surface roughness. Boothe teaches that a surface roughness of about 3 micrometers is used in combination with a vacuum to keep elongated parts in their elongated state for transfer. (Col. 3, lines 36-39.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the surface of Oshefsky in view of McCabe and Allen be roughened as taught by Boothe, because Boothe teaches that the roughened surface helps keep the object being transferred in an elongated state, thus ensuring proper transfer to the web.

Regarding claim 8, Oshefsky in view of McCabe and Allen does not disclose the outer surface having a plasma coating thereon. Boothe teaches having the outer surface (46) of each transfer segment (40) be textured to define a surface roughness which assists in gripping and maintaining the discrete parts (26) on the outer surface (46). To achieve the desired surface roughness, the outer surface (46) of each transfer segment (40) may also include a coating such as a plasma coating as are known to those skilled in the art. (Col. 6, lines 15-41.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the surface of Oshefsky in view of McCabe and Allen coated by plasma as taught by Boothe, because Boothe teaches that such plasma coatings are known to those of ordinary skill in the art to achieve a desired roughened surface, thus helping hold the object to be transferred.

10. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothe et al. (US Patent No. 5,716,478) in view of Schroth et al. (US Patent No. 4,608,115).

Art Unit: 1734

Boothe discloses an apparatus for severing a first substrate web traveling at a first speed into discrete parts and applying the discrete parts onto a second substrate web traveling at a second speed. The apparatus includes the following:

(a) a product web (28) conveyor which enables the web (28) to be traveling at a certain speed;

(b) at least one transfer segment (40) which is configured to rotate about a first axis (44), the transfer segment (40) includes an outer surface which is configured to receive the discrete parts and apply the discrete parts to the second substrate web (28), the outer surface (46) may also include a plurality of holes therein through which a relatively low pressure or vacuum can be drawn;

(c) a drive ring (60) which is configured to rotate about a second axis (64) which is offset from the first axis (44) of the transfer segment (40);

(d) at least one coupler arm (70) is pivotally connected to the drive ring (60) about a pivot point (72), where the coupler (70) arm includes a cam end (76) which is configured to follow a predetermined curvilinear path and a crank end (78) which is slidably connected to the transfer segment (40);

(e) a drive mechanism is configured to rotate the drive ring (60) about the second axis (64), as the drive ring (60) is rotated, the cam end (76) of the coupler arm (70) is guided along the curvilinear path and the crank end (78) of the coupler arm (70) slidably engages the transfer segment (40) thereby pivoting the coupler arm (70) about the pivot point (72) to vary an effective drive radius of the transfer segment (40) and rotate the transfer segment (40) at a variable speed. (Col. 2, lines 48-67; Col. 3, lines 1-7; Col. 5, line 24 through Col. 8, line 65.)

While Boothe et al. does not explicitly show the apparatus structure which enables the product web to be supported and advanced as required by the claim. The structure is

Art Unit: 1734

inherent in such an apparatus otherwise the apparatus could not operate properly. An example of such structure is shown in Figure 1A of Schroth et al. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a web conveyor mechanism in the apparatus of Boothe which supports and advances the substrate web, because such a conveyor is needed to make the apparatus function properly.

Boothe does not disclose the surface of the transfer segment (40) to have a recessed portion having a bottom surface as required by the claim. Schroth et al. discloses transfer roller for applying a first material to a continually moving web. Figures 5 and 6 show the transfer segment (32) which includes a recessed portion having a bottom surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a recessed portion in the device of Boothe, because Schroth shows that use of a recessed portion is within the purview of one having ordinary skill in the art.

Furthermore, Booth teaches that the outer surface (46) of the transfer member (40) can have a rough surface to assist in gripping and maintaining the discrete parts there on. (Boothe, Col. 6, lines 15-20.) Schroth includes a recessed portion with a screen (115) over the portion to help distribute the vacuum and ensure the vacuum created at the bottom of the recess portion engages the discrete part. (Schroth, Col. 5, lines 45-51.)

Regarding claim 18, in use the transfer segment (40) is configured to maintain a substantially constant first surface speed as the discrete parts are received and a substantially constant second surface speed as the discrete parts are applied to the second substrate web. (Col. 3, lines 3-7.)

Regarding claim 19, the first surface speed of the transfer segment (40) is substantially equal to the speed of the discrete parts and the second surface speed of the transfer segment (40) is substantially equal to the second speed of the second substrate web. (Col. 4, lines 1-7.)

Art Unit: 1734

Regarding claim 20, Boothe includes a turning mechanism (110) for rotating the discrete parts (26) before they are applied to the second substrate web (28).

11. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothe et al. (US Patent No. 5,716,478) in view of Schroth et al. (US Patent No. 4,608,115) and Allen (US Patent No. 5,583,530).

Boothe discloses an apparatus for severing a first substrate web traveling at a first speed into discrete parts and applying the discrete parts onto a second substrate web traveling at a second speed. The apparatus includes the following:

- (a) a product web (28) conveyor which enables the web (28) to be traveling at a certain speed;

- (b) at least one transfer segment (40) which is configured to rotate about a first axis (44), the transfer segment (40) includes an outer surface which is configured to receive the discrete parts and apply the discrete parts to the second substrate web (28), the outer surface (46) may also include a plurality of holes therein through which a relatively low pressure or vacuum can be drawn;

- (c) a drive ring (60) which is configured to rotate about a second axis (64) which is offset from the first axis (44) of the transfer segment (40);

- (d) at least one coupler arm (70) is pivotally connected to the drive ring (60) about a pivot point (72), where the coupler (70) arm includes a cam end (76) which is configured to follow a predetermined curvilinear path and a crank end (78) which is slidably connected to the transfer segment (40);

- (e) a drive mechanism is configured to rotate the drive ring (60) about the second axis (64), as the drive ring (60) is rotated, the cam end (76) of the coupler arm (70) is guided along the curvilinear path and the crank end (78) of the coupler arm (70) slidably engages the transfer segment (40) thereby pivoting the coupler arm (70) about the pivot

Art Unit: 1734

point (72) to vary an effective drive radius of the transfer segment (40) and rotate the transfer segment (40) at a variable speed. (Col. 2, lines 48-67; Col. 3, lines 1-7; Col. 5, line 24 through Col. 8, line 65.)

While Boothe et al. does not explicitly show the apparatus structure which enables the product web to be supported and advanced as required by the claim. The structure is inherent in such an apparatus otherwise the apparatus could not operate properly. An example of such structure is shown in Figure 1A of Schroth et al. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a web conveyor mechanism in the apparatus of Boothe which supports and advances the substrate web, because such a conveyor is needed to make the apparatus function properly.

Boothe does not disclose the surface of the transfer segment (40) to have a recessed portion having a bottom surface as required by the claim. Allen discloses a label applicator which picks up a label (24) from a web (32) and teaches applying the label to an article (26). The applicator in Figure 6 shows the receiving face (62) having a recess (68) with a bottom surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a recess on the transfer element in Boothe motivated by the fact that Allen teaches a recess is particularly helpful for labels with a relative thickness. Therefore, when there is a concern for the thickness of the element being transferred then a recess is within the purview of the artisan as taught by Allen.

Regarding claim 18, in use the transfer segment (40) is configured to maintain a substantially constant first surface speed as the discrete parts are received and a substantially constant second surface speed as the discrete parts are applied to the second substrate web. (Col. 3, lines 3-7.)

Regarding claim 19, the first surface speed of the transfer segment (40) is substantially equal to the speed of the discrete parts and the second surface speed of the

Art Unit: 1734

transfer segment (40) is substantially equal to the second speed of the second substrate web. (Col. 4, lines 1-7.)

Regarding claim 20, Boothe includes a turning mechanism (110) for rotating the discrete parts (26) before they are applied to the second substrate web (28).

12. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothe et al. (US Patent No. 5,716,478) in view of McCabe et al. (US Patent No. 6,482,278 B1) and Allen (US Patent No. 5,583,530).

Boothe discloses an apparatus for severing a first substrate web traveling at a first speed into discrete parts and applying the discrete parts onto a second substrate web traveling at a second speed. The apparatus includes the following:

- (a) a product web (28) conveyor which enables the web (28) to be traveling at a certain speed;

- (b) at least one transfer segment (40) which is configured to rotate about a first axis (44), the transfer segment (40) includes an outer surface which is configured to receive the discrete parts and apply the discrete parts to the second substrate web (28), the outer surface (46) may also include a plurality of holes therein through which a relatively low pressure or vacuum can be drawn;

- (c) a drive ring (60) which is configured to rotate about a second axis (64) which is offset from the first axis (44) of the transfer segment (40);

- (d) at least one coupler arm (70) is pivotally connected to the drive ring (60) about a pivot point (72), where the coupler (70) arm includes a cam end (76) which is configured to follow a predetermined curvilinear path and a crank end (78) which is slidably connected to the transfer segment (40);

- (e) a drive mechanism is configured to rotate the drive ring (60) about the second axis (64), as the drive ring (60) is rotated, the cam end (76) of the coupler arm (70) is

Art Unit: 1734

guided along the curvilinear path and the crank end (78) of the coupler arm (70) slidably engages the transfer segment (40) thereby pivoting the coupler arm (70) about the pivot point (72) to vary an effective drive radius of the transfer segment (40) and rotate the transfer segment (40) at a variable speed. (Col. 2, lines 48-67; Col. 3, lines 1-7; Col. 5, line 24 through Col. 8, line 65.)

While Boothe et al. does not explicitly show the apparatus structure which enables the product web to be supported and advanced as required by the claim. The structure is inherent in such an apparatus otherwise the apparatus could not operate properly. An example of such structure is shown in Figures 1A and 2 of McCabe et al. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a web conveyor mechanism in the apparatus of Boothe which supports and advances the substrate web, because such a conveyor is needed to make the apparatus function properly.

Boothe does not disclose the surface of the transfer segment (40) to have a recessed portion having a bottom surface as required by the claim. The device of Boothe is for leg elastics, but a similar transfer mechanism (42) is shown in McCabe which is used for absorbent pads. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the device of Boothe could also be used to transport absorbent pads as shown in McCabe.

Allen discloses a label applicator which picks up a label (24) from a web (32) and teaches applying the label to an article (26). The applicator in Figure 6 shows the receiving face (62) having a recess (68) with a bottom surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a recess on the transfer element in Boothe in view of McCabe when the transfer elements are transferring absorbent pads motivated by the fact that Allen teaches a recess is particularly helpful for

Art Unit: 1734

labels with a relative thickness and absorbent pads are known to have a thickness.

Therefore, when there is a concern for the thickness of the element being transferred then a recess is within the purview of the artisan as taught by Allen.

Regarding claim 18, in use the transfer segment (40) is configured to maintain a substantially constant first surface speed as the discrete parts are received and a substantially constant second surface speed as the discrete parts are applied to the second substrate web. (Col. 3, lines 3-7.)

Regarding claim 19, the first surface speed of the transfer segment (40) is substantially equal to the speed of the discrete parts and the second surface speed of the transfer segment (40) is substantially equal to the second speed of the second substrate web. (Col. 4, lines 1-7.)

Regarding claim 20, Boothe includes a turning mechanism (110) for rotating the discrete parts (26) before they are applied to the second substrate web (28).

Response to Arguments

13. Applicant's arguments with respect to claim 21 have been considered but are moot in view of the new grounds of rejection.

Conclusion

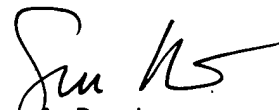
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone

Art Unit: 1734

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
November 16, 2005